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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,502	10/29/2003	John S. Csapo	2003.10.004.WS0	5747
23990 7590 04/24/2007 DOCKET CLERK P.O. DRAWER 800889 DALLAS, TX 75380			EXAMINER SANTIAGO CORDERO, MARIVELISSE	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 04/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/696,502

Applicant(s)

CSAPO ET AL.

Examiner

Marivelisse Santiago-Cordero

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 4/11/07 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

*Continuation Sheet*

Continuation of 11:

Applicant's arguments filed on 4/11/07 have been fully considered but they are not persuasive.

Applicant argues that Jolma (Patent No.: 6,011,971) fails to disclose a hard handoff region, or that it is a portion of the second wireless network, or that the hard handoff is performed when the mobile station reaches a border of the hard handoff region (Remarks: page 10, 1<sup>st</sup> paragraph). In response, the Examiner respectfully disagrees. As stated in the last Office Action, Jolma performs a hard handoff between overlapping stations BTS11 and BTS 21 (Fig. 4; col. 5, lines 35-39 and 49-53).

At the outset, it is noted that the figure 4 relied upon by applicant in the Remarks section (page 10) does not correspond to the cited Jolma reference.

In addition, it is an inherent feature, and/or an obvious expedient thereof, that to perform a successful hard handoff for a mobile station between two base transceiver stations in different networks, such mobile station must reach a border of a hard handoff region or must be located in the hard handoff region. Once it is determined that the mobile station is in a hard handoff region, the base station controller decides, among other things, whether the hard handoff should occur, to which base station, and/or when it should occur. Accordingly, since Jolma does teach BTS11 and BTS21 in overlapping arrangement and successfully performing the hard handoff between these stations (Fig. 4; col. 5, lines 35-39 and 49-53), the mobile station must have reached a border of a hard handoff region and/or must have been located in a hard handoff region; thus, disclosing a hard handoff region that it is a portion of the second wireless network, and the hard

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handoff is performed when the mobile station reaches a border of the hard handoff region as claimed.

Further, Applicant argues that the limitations of the independent claims happen at a specific time (Remarks: page 11, 4<sup>th</sup> paragraph), i.e., at the point that the mobile station reaches a border of the hard handoff region, the hard handoff is performed (Remarks: page 12, 1<sup>st</sup> full paragraph). In response, Applicant's arguments are more specific than claims. It is noted that the features upon which applicant relies (i.e., at **a specific time** or **at the point** that the mobile station reaches a border of the hard handoff region) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Broadly interpreted, the claim recites a conditional limitation (i.e., when the mobile station reaches a border for a handoff region), that, if met, an action is taken (the hard handoff is performed). As stated above, since Jolma does teach BTS11 and BTS21 in overlapping arrangement and successfully performing the hard handoff between these stations (Fig. 4; col. 5, lines 35-39 and 49-53), the mobile station must have reached a border of a hard handoff region and must have been located in a hard handoff region. During patent examination, the claims must be given their broadest reasonable interpretation. See MPEP 2111.

Furthermore, regarding claims 1-3, 5-8, and 10, it is noted that the apparatus claim only require the components to have the capability to so perform (note the multiple recitations of "operable to" throughout the claims). Citations in the last Office Action and the response above clearly show evidence that the apparatus is "operable to" perform the claimed functions. While the features of an apparatus may be recited either structurally or functionally, claims directed to

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an apparatus must be distinguished from the prior art in terms of structure rather than function.

See MPEP 2114. In addition, the manner of operating the device does not differentiate apparatus claim from the prior art. See MPEP 2114.



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